The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES P. BUCKLEY, DANIA I. GHANTOUS, KHANH HOANG, CRAIG R. HORNE, and XIANGXIN BI

Appeal No. 2005-1249
Application No. 09/435,748

ON BRIEF

Before KIMLIN, GARRIS, and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is hereby remanded to the jurisdiction of the Examining Corps, via the Office of the Director of Technology Center 1700, because the record before us is not in a condition which permits an informed and meaningful appellate review. There are a number of reasons for this circumstance.

First, the section 112, second paragraph, rejection set forth in the answer is not entirely consistent with the corresponding rejection advanced by the examiner during prosecution. Specifically, the subject appeal is from the rejections set forth in the Office action mailed July 9, 2004 (see page 1 of the supplemental appeal brief filed July 28, 2004). The section 112, second paragraph, rejection presented on page 2 of this Office action involves claims 29-44, 52-54 and 58-77. In contrast, the section 112, second paragraph, rejection presented on page 4 of the answer, mailed November 15, 2004, involves not only the aforementioned claims but additionally claims 78-89. Because this answer was mailed subsequent to the September 13, 2004 date on which new rules of practice became effective, a new ground of rejection in the answer is permitted under 37 CFR § 41.39. However, the section 112, second paragraph, rejection of additional claims 78-89 on page 4 of the answer is not designated as a new ground of rejection pursuant to the aforenoted regulation.

In response to this remand, the examiner must resolve the claim inconsistency raised by the section 112, second paragraph, rejections as presented in the July 9, 2004 Office action as compared with the November 15, 2004 examiner's answer. If the

rejection of additional claims 78-89 on page 4 of the answer constitutes a new ground of rejection, the examiner must prepare and mail a corrected examiner's answer in which the new ground of rejection is designated as such in conformance with 37 CFR § 41.39(a)(2)(September 13, 2004). On the other hand, if the examiner determines that the rejection of these additional claims does not constitute a new ground of rejection, the examiner must provide the record with a written exposition in support of this determination. Similarly, if the examiner drops these additional claims 78-89 from his outstanding section 112, second paragraph, rejection, the examiner must provide the record with a written explanation of why the additional claims do not involve the same indefiniteness issues that are said to be present in the other rejected claims.

In addition to the foregoing, we observe that the appellants and the examiner disagree as to whether certain of the appealed claims have been separately grouped and argued in accordance with then existing regulation 37 CFR § 1.192(c)(7)(2003). This disagreement is clearly revealed by a comparison of the claim grouping statements which appear on page 5 of the supplemental brief, on page 2 of the examiner's answer, and on page 2 of the reply brief. As an apparent consequence of this disagreement,

the answer does not contain an express response to arguments presented in the brief concerning the separate claim groupings (e.g., compare the arguments on pages 19-27 of the supplemental brief with the response to these arguments presented on pages 15-21 of the answer). Likewise, the record before us contains no acknowledgment of or rebuttal to the claim grouping disagreement expressed by the appellants on page 2 of the reply brief since the only response by the examiner to this reply brief has been to note it (see the examiner's communication mailed March 29, 2005).

In response to this remand, the examiner must review the holding that the claims stand or fall together. If upon reconsideration, appellants' groupings are found to be in compliance with 37 CFR § 1.192(c)(7), the examiner must provide the record of this appeal with a separate discussion of each and every argument for each and every separate claim grouping presented by the appellants in their supplemental brief and reply brief. If these arguments are considered by the examiner to be merely a reiteration of claim differences rather than meritorious arguments for patentability (i.e., as indicated on page 2 of the answer), then the appropriation action is to provide appellants with a notice of non-compliance under 37 CFR § 1.192(d). See Ex parte Ohsumi, 21 USPQ2d 1020, 1023 (Bd. Pat. App. & Int. 1991).

Compare current regulation 37 CFR § 41.37(d)(September 2004). The examiner must provide the record with written support for such a position in the notice of non-compliance, and this written support must be made with respect to each claim grouping presented in the supplemental brief and reply brief. We note that a holding that a brief does not comply with 37 CFR § 1.192(c) is a petitionable matter, not an appealable matter. Ohsumi, 21 USPQ2d at 1023.

The record of this appeal also appears to be incomplete with respect to the examiner's section 112, first paragraph, rejection of all appealed claims for violating the written description requirement. This is because neither the supplemental brief (see page 18) or the reply brief (see page 2) contains a reasonably specific argument concerning the aspect of this rejection which involves the "less than about 4.5 microns" limitation recited in claims 84-89 (compare the sentence bridging pages 3 and 4 of the answer).

In response to this remand, the examiner must determine whether this circumstance causes the supplemental brief to be defective (again see 37 CFR 1.192(d) and compare 37 CFR 41.37(d)) as discussed in the Manual of Patent Examining Procedure (MPEP) section 1206 under the heading "Review of Brief by Examiner" at

page 1200-11 (August 2001). If so, the examiner must follow the guidelines set forth in this MPEP section. On the other hand, if the examiner does not consider the supplemental brief to be defective under the above discussed circumstance, the examiner must provide the record with a written exposition of his basis for such a determination.

Finally, we observe that several of the examiner's section 103 rejections involve obviousness conclusions (e.g., see pages 7, 9 and 11 of the answer) regarding claim features (e.g., electrodes with an average thickness of less than about 10 microns) which appear to be relevant not only to the claims rejected under section 103 but also the claims which are rejected under section 102. In this regard, we further observe that the claims which are rejected under section 102 have not been alternatively rejected under section 103. As a result, if an ultimate appellate review leads to reversal of the section 102 rejection and affirmance of the section 103 rejections, the result would be the presence of unrejected claims which appear to be patentably indistinguishable from claims which remain under a section 103 rejection. Therefore, in responding to this remand, the examiner should consider making an alternative section 103 rejection, where appropriate, of claims currently rejected under

section 102 only. If the examiner determines that such an alternative section 103 rejection would not be appropriate, the examiner must provide the record with a written explanation of this determination.

The responses to this remand made by the examiner or by the appellants should conform to our current regulations concerning ex parte appeals at 37 CFR § 41.30 et seq. (September 13, 2004).

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01(D)(8th ed., Rev. 2, May 2004). It is important that the Board be promptly informed of any action affecting the appeal in this case.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is ***not*** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

REMANDED

Edward C. Kimlin)
Administrative Patent Judge)
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Bradley R. Garris) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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Catherine Timm)
Administrative Patent Judge)

BRG:tdl

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Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100